

REMARKS

Reconsideration of the present patent application is respectfully requested. Claims 1-24 are pending in this application. Claims 1-6, 8-13, and 15-23 are rejected. Claims 7, 14, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this amendment, claims 1, 8, 15, and 17 are amended and claims 2, 9, and 16 are canceled.

Claims 1-2, 4, 8-9, 11, 15-16, and 19 were rejected under 35 U.S.C. §102(a) as being anticipated by Fogg (United States patent No. 5,337,236). Independent claims 1 and 8, as amended, incorporate the language of dependent claims 2 and 9 to recite, in pertinent part, that “*an output device* in circuit communication with the processing unit and *capable of communicating* the cumulative mileage in the *form of a signal* in response to the code, wherein the code is an ON-OFF code and the signal is an ON-OFF signal” (emphasis added). Independent claim 15, as amended, recites that the output device communicates “cumulative mileage in the form of a *series of pulses*” (emphasis added). Fogg does not teach an output device which communicates cumulative mileage in the form of an ON-OFF signal or a series of pulses. Fogg, instead, uses an alpha-numeric display or printer as the output device (*see* Office Action, page 2, paragraph 2). Both the display and the printer communicate cumulative mileage by alpha-numeric text, not an ON-OFF signal.

The language in claims 2 and 9 have been included, by amendment, into claims 1 and 8. The Office Action rejected claims 2 and 9 concluding that the system of Fogg processes data in digital code and that it is inherent that digital coded data comprises an ON-OFF signal. This conclusion is inconsistent with the language of claims 1 and 8, as amended. Specifically, claims 1 and 8 claim an output device capable of communicating cumulative mileage in the form of an ON-OFF signal. The output devices in Fogg communicate cumulative mileage data in the form of alpha-numeric text, not an ON-OFF signal.

Since Fogg does not teach or disclose the claimed invention, claims 1, 8, and 15, as amended, are not anticipated by the cited reference. Claims 4, 11, and 19 depend from claims 1, 8, and 15, respectively. Since the Fogg reference does not disclose all of the limitations of claims 1, 8, and 15, as amended, Applicant submits that claims 4, 11, and 19 are patentable at

least by virtue of their dependency from claims 1, 8, and 15, respectively. Accordingly, Applicant respectfully requests that the rejections of claims 1, 4, 8, 11, 15, and 19 be reconsidered and withdrawn.

Claims 3, 10, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fogg in view of Chang (U.S. Patent No. 5,602,563). Claims 5, 12, 17, 20, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fogg in view of McCann (U.S. Patent No. 6,343,844). Claims 6, 13, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fogg in view of Horie (U.S. Patent No. 5,748,076).

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. *See MPEP §2143*. As a result, in order for the Examiner to maintain a rejection under 35 U.S.C. §103(a), the references must teach all of the limitations of the claims. Applicant respectfully submits that the combination of Fogg and Chang fails to teach or suggest all of the claim limitations as set forth in the independent claims of the present invention.

Specifically, neither Fogg nor Chang teach or suggest an output device which communicates information in the form of an ON-OFF signal or a series of pulses. Both Fogg and Chang, instead, teach that information is communicated via an alpha-numeric display or a printer. Since neither Fogg nor Chang teach or disclose the claimed invention, claims 3, 10, and 18, as amended, are not rendered obvious by the cited references. Accordingly, Applicant respectfully requests that the rejections of claims 3, 10 and 18 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

When relying on multiple references, it is incumbent upon the Examiner to identify some suggestion or motivation to combine the references. *In re Mayne*, 104 F.3d 1339, 41 U.S.P.Q.2d. 1451 (Fed. Cir. 1997). Obviousness cannot be established by simply combining the references, absent some suggestion or teaching within the references supporting the combination. *Carella v. Starlight Archery*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). If the proposed combination of the prior art would change the principle operation of the prior art, then the teachings of the prior art are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959)). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there it no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

There is no suggestion or motivation to combine the Fogg reference with either the McCann reference or the Horie reference. First, the proposed combinations would change the principle of operation of the system in Fogg. The object of the Fogg system is to provide an improved vehicle distance recorder that permits the user to define and display trip codes, provide a dated summary of distance traveled for each trip code, and provide for easy and accurate calibration (*see col. 2, lines 36-48*). The specification in Fogg illustrates that in addition to mileage data, the character display provides questions and prompts to the user, such as "SELECT" (col. 4, line 12), "PRINTING" (col. 4, line 38), FROMDATE (col. 5, line 7), and "KEY#?" (col. 5, line 35). Fogg accomplishes this by providing a twelve button keypad and an eight character alpha-numeric display. Replacing the alpha-numeric display with the output device of McCann or Horie changes the principle of operation of the Fogg system by removing the ability of the display to provide prompts or questions to the user. Further, removing the ability of the display to provide prompts or questions to the user renders the system unsatisfactory for its intended purpose of providing a system where the user can program and set-up multiple trip codes across different dates and providing a means for easy calibration (*see col. 2, lines 36-48*).

Second, the Fogg system already includes an output device which serves the function that the Office Action argues to add by the combination of McCann and Horie. The Office Action's reasoning for motivation to replace the alpha-numeric display is speculative and contrary to the intended purpose of the Fogg system. Neither the Fogg, the McCann, nor the Horie reference provide any support for the Office Action's reasoning.

Accordingly, Applicant respectfully requests that the rejections of claims 5-6, 12-13, 17, 20-21, and 23 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Regarding the rejection of Claim 17 under 35 U.S.C. §103(a) as being unpatentable over Fogg in view of McCann, the Office Action admits that neither Fogg nor McCann teach representing zero as a strobe signal. The Office Action, however, concludes that it is obvious because a designer can choose to do so.

The characterization of certain claim limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Examiner to

establish a factual basis to support the legal conclusion of obviousness. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *See In re Lalu*, 747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984). Furthermore, an Examiner may not rely on official notice, or judicial notice, or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *See Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). Here, one of the points of novelty is having the encoded numeral zero be represented in the series of pulses by a strobe signal. *See* claim 17. The Examiner has not cited, nor has the Applicant identified, any prior art which suggests or teaches this.

Applicants respectfully request the Examiner cite references and provide evidence for her conclusory statements. MPEP §§2144.03, 2144.04 (case citations omitted). Otherwise, unsupported statements and conclusions of obviousness are considered inadmissible hindsight. *See, e.g., In re Geiger*, 2 U.S.P.Q.2d. 1276 (Fed. Cir. 1987), Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d. 1593 (Fed. Cir. 1987), In re Gordon, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), Ex parte Clapp, 227 U.S.P.Q. 972 (Pat. Off. Bd. App. & Inter. 1985), Ex parte Shepard and Gushue, 188 U.S.P.Q. 537 (Pat. Off. Bd. App. 1974). None of the Examiner's statements in paragraph 5 regarding claim 17 is supported, and the statements are, therefore, without legal basis.

Applicant contends that the independent base claims, as amended, are allowable. Therefore, Applicant withdraws amending claims 7, 14 and 24 to be written in independent form until Applicant's arguments for patentability of the base claims has been considered.

CONCLUSION

Based on the foregoing remarks and amendments, Applicant believes that all of the claims in this case are now in condition for allowance and an indication to that effect is respectfully requested. Furthermore, if the Examiner believes that additional discussions or information might advance the prosecution of this case, the Examiner should feel free to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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